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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,120

06/16/2006

Carine Boursier

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BUCHANAN, INGERSOLL & ROONEY PC
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EXAMINER

OBAYANJU, OMONIYI

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

07/07/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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offserv@bipc.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/583,120	Applicant(s) BOURSIER ET AL.	
	Examiner OMONIYI OBAYANJU	Art Unit 2617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 June 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 2,4-7 and 9-20.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/KAMRAN AFSHAR/
 Supervisory Patent Examiner, Art Unit 2617

/O. O./
 Examiner, Art Unit 2617

Continuation of 3. NOTE: 1. Applicant's arguments filed 06/16/2011 have been fully considered but they are not persuasive. As first matter, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. As discussed in the background portion of the application, a problem that has arisen in the mobile telephone industry is the theft of handsets. In an effort to thwart the reuse of stolen handsets, the unique identifier of a stolen handset, namely its International Mobile Equipment Identity (IMEI), is placed on a black list. When a handset is used on a mobile network, its IMEI is transmitted to the network operator. By checking a received IMEI against the black list, the network operator can block the use of handsets which have been reported to be stolen. However, as noted on page 2 of the specification, it has become fairly easy to get around the hurdles of a black list, by modifying the IMEI of a handset. To this end, in more recently manufactured handsets, the IMEI is stored in a memory that inhibits physical modification of the IMEI, such as a PROM. However, even this further effort to inhibit the use of stolen handsets is not totally successful. As noted in the last paragraph on page 2 of the specification, if a fraudulent operating system is implemented on the handset, it may modify the IMEI that is retrieved from the physically secure memory before sending it on to the network, and thus avoid the black list prohibition. The claimed subject matter addresses this latter concern, to inhibit rogue software within the handset from modifying the IMEI as it is being transferred from the physically secure memory to the network. In accordance with the claimed invention, a secure electronic module, e.g. a SIM card within the mobile handset, authenticates a storage module that stores the IMEI. Once the storage module has been authenticated, a secure communication channel is established between the storage module and the secure electronic module. For instance, Figure 1 of the present application illustrates an example of a handset 1 having a storage support 2, e.g. PROM, and a secure module 31, e.g. SIM card, housed in a connector 3. The secure communication channel between the PROM 2 and the SIM card 31 is represented by reference number 6. This secure communication channel is used to transmit the IMEI from the storage module to the secure electronic module, to thereby enable the handset to access the mobile communication network. Thus, by establishing this secure communication channel between the storage module and the secure electronic module, and using this secure channel for the transfer of the IMEI, any fraudulent software that may be resident on the handset is inhibited from modifying the IMEI during the transfer.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

3. In response to applicant's argument that the reference Simmons (US Publication No. 20040043792) fails to show certain features of Applicant's invention (i.e. authenticate, by the secure electronic module, the storage support module) In this case, Examiner very kindly directs the Applicant to Simmons e.g. (Page 3, [0030] and fig. 2) that the SIM Card authenticates the mobile equipment, [0041] further teaches that the authenticating key or algorithm is based on the mobile equipment's IMEI, with the smart card receiving the IMEI from the ME. (Emphases added). On the other hand, in an analogous field of endeavor, Portalier teaches the concept of establishing a secure communication channel between the storage support module and the secure electronic module (See Portalier e.g. Coupling by means of an encryption algorithm between the subscriber identity code of the SIM card and the IMEI identity code of the mobile telephone, Page 3, lines 21-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide above teaching of Simmons to Portalier to provide an efficient, reliable, and secure communication link between devices in communication system and to avoid theft of a communication device (See, Portalier, Page 1, lines 1-5).

Applicant(s) are reminded that the Examiner is entitled to give the broadest reasonable interpretation to the language of the claim. The Examiner is not limited to Applicant's definition, which is not specifically set forth in the claims, *In re Tanaka et al*, 193 USPQ 139, (CCPA) 1977. Therefore, the previous rejection is maintained..